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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,738	01/27/2004	James M. McDonough	APD-001	1102

34203 7590 05/16/2005

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EXAMINER

WONG, STEVEN B

ART UNIT PAPER NUMBER

3711

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/765,738	Applicant(s) MCDONOUGH ET AL.	
	Examiner Steven Wong	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5-19 is/are rejected.
- 7) ☒ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. Applicant's amendments and remarks have overcome the rejections thereto.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 2, 5-7, 10, 11 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Chase (3,414,268).

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (3,414,268). Note the basis for the rejections set forth in the Office Action mailed December 2, 2004.
6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chase (3,414,268) in view of Andrikian (5,383,668). Note the basis for the rejections set forth in the Office Action mailed December 2, 2004.
7. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson (5,301,950). Note the basis for the rejections set forth in the Office Action mailed December 2, 2004.

Allowable Subject Matter

8. Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments filed February 21, 2005 have been fully considered but are not deemed to be persuasive. Regarding the applicant's statement on the location of the web member in Chase, the applicant is correct in his illustration labeling the web member. As stated in the first Office Action, the web member extends between the legs and connects them. The applicant asserts that the web does not extend between the leg members and is not independent of the shaft because the leg members extend radially from the cup. However, this is not persuasive as Figures 1 and 2 of Chase show the web member as extending between the leg members. Figure 2 is a cross section of Figure 1 between the leg members. Figure 2 clearly shows a member extending between and interconnecting the leg members. Attention is directed to the examiner's notations on attached Figure 1 of Chase showing the location of the web member. While Chase may state that the leg members extend radially from the cup, this does not preclude the web from interconnecting the leg members.

Regarding the applicant's argument that the legs (17) of Chase are not attached to the shaft (15A), this argument is also not persuasive. It is noted that the claim does not state that the legs are directly attached to the shaft and also uses the open language "comprising". Therefore, the embodiment where the legs are attached to cup or bore (16) which is then attached to shaft (15A) meets the claim limitations.

Regarding claim 5, the applicant argues that they are unaware of any tee that is used with a practice mat that has a point. However, this argument is not persuasive as the claim fails to positively define the practice mat in combination with the tee. Claim 5 merely recites that the top portion of the tee be of a collapsible material so that it may fit through an opening a practice

Art Unit: 3711

mat. The top portion of the tee of Chase is made from a flexible material. In order to anticipate the claim limitations, the top portion of the tee needs merely be of a flexible material and be capable of fitting through an opening in a practice mat. Since the practice mat is not claimed *per se*, the actual use of the tee of Chase in a practice mat is not required.

Regarding claim 11, the applicant argues that the golf ball shown in Figure 5 of Chase appears to contact more than just a portion of the legs. However, this is not persuasive as the leg members of Chase define multiple portions such as an end portion, a top portion and an underside portion. The golf ball as shown in Figure 5 only contacts the top portion of the leg members.

Regarding claim 14, the applicant argues that element 12 of Chase is not a base but is rather a shaft. However, this is not persuasive, because even though Chase refers to the member as a shaft, it still fulfills the definition of a base. Note the attached definition for base stating that a base is a “fundamental part of something” or a “support”. Clearly, element 12 of Chase satisfies this definition. Further, note the illustration provided with the definition denoting several elements that may comprise the base (1-6).

Regarding claim 12, the applicant argues that there is no suggestion to combine the teachings of Chase and Andrikian and that the references teach away from one another. However, this is not persuasive as both inventions are directed to golf tees and nothing in the disclosure of Chase would preclude the modification as recited. The applicant points to the last three lines of column 3 of Chase as a statement teaching away from combining the teachings of Chase and Andrikian. However, this citation is not seen as precluding one of ordinary skill in the art from modifying the shaft of the tee of Chase with an enlarged base in order to allow the

Art Unit: 3711

the art from modifying the shaft of the tee of Chase with an enlarged base in order to allow the tee to be used in a driving range environment. Applicant's assertion that the examiner does not provide any reasoning as to why those two tees should be combined is not well taken. In the rejection of claim 12, the Office Action clearly states that it would have been obvious to one of ordinary skill in the art to form the tee of Chase with an enlarged base in order to allow the tee to be used in a driving range environment.

Regarding the applicant's argument that the tee of Andrikian is used to facilitate teeing of the ball, Andrikian is cited as a secondary reference and relied upon merely for its teaching that it is well known in the art of golf tees to provide enlarged bases for the driving range tees.

Regarding claims 17-19, the applicant argues that they cannot find a plurality of legs in the reference to Patterson. Attention is directed to the attached definition of "leg" from Webster's Ninth New Collegiate Dictionary where it is defined as a leg of a triangle. Element 30 denotes an edge of the hollow stem portion. The edge is a leg. It should also be noted that irregardless of an express teaching by Patterson for a plurality of legs, he does expressly suggest modifying the tee to provide additional legs for the tee. Note column 6, lines 15-20. Instant claims 17 and 18 recite three legs and instant claim 19 recites four legs. It would have been obvious to one of ordinary skill in the art to provide additional strips for the tee and thus create additional legs (at least four) in order to allow the golfer to tee the golf ball from various positions.

The applicant also argues that the resilient strip (32) of Chase functions as a leg and must be such as it provides support to the golf ball. However, even though the resilient strip (32) of Chase may support the teed golf ball, such is not seen as precluding the strip from being called a

Art Unit: 3711

web member especially given the fact that it accomplishes the same function as the web member of the instant invention.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

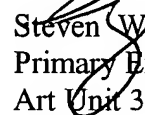
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
May 9, 2005

Dec. 3, 1968

H. H. CHASE

3,414,268

GOLF TEE WITH SEAT FORMED BY COACTING CENTRAL
PART AND RADIATING PETALS

Filed Sept. 24, 1965

2 Sheets-Sheet 1

FIG. 1.

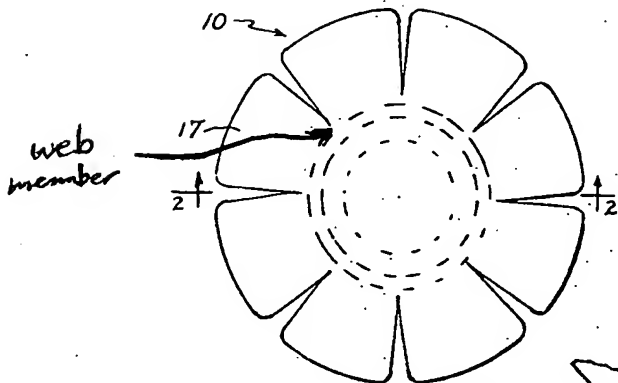


FIG. 2.

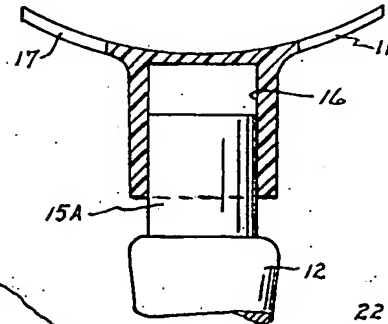


FIG. 3.

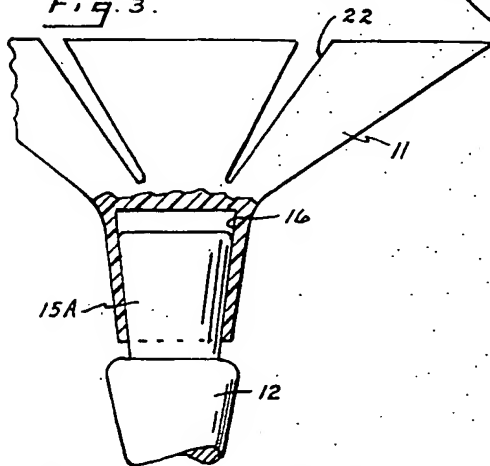


FIG. 5.

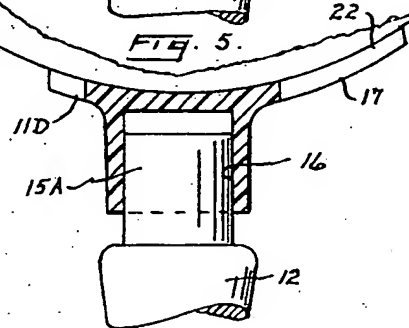


FIG. 4.

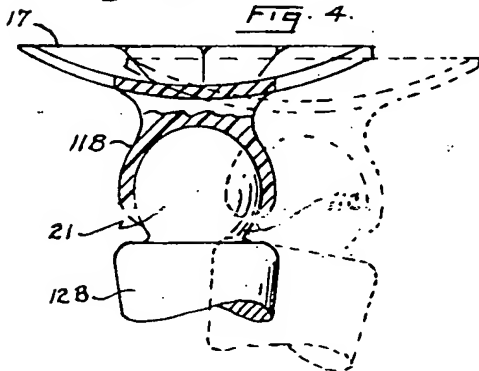
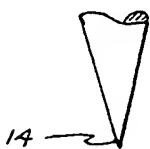
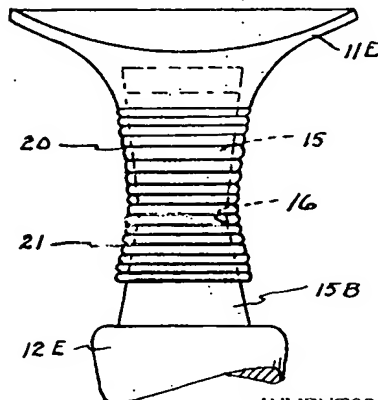


FIG. 6.



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AGENT